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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/616,602

07/10/2003

Dwight Marcus

8016-0011

3611

24201

7590

01/30/2006

FULWIDER PATTON

6060 CENTER DRIVE

10TH FLOOR

LOS ANGELES, CA 90045

EXAMINER

ALAM, SHAHID AL

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/616,602	Applicant(s) MARCUS, DWIGHT	
	Examiner Shahid Al Alam	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 104-130 is/are pending in the application.
 4a) Of the above claim(s) 111-130 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 104-110 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>09172004</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09142004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Reissue Applications

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,032,156 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 104 – 110, drawn to creation of media programming where a set of style data and different configured layer to store, control, define, provide and associate media elements, classified in class 715, subclass 908.
 - II. Claims 111 – 116, 120, 121 – 126 and 130, drawn to creating media clip (motion clip) and media clip editing, classified in class 715, subclass 500.1.

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- III. Claims 117 – 119 and 127 – 129, drawn to creating media programming, profiling a viewer and concatenating media clips, classified in class 707, subclass 104.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions listed as Group I, Group II and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention has separate utility such as follows:

Group I. Creation of media programming where a set of style data and different configured layer to store, control, define, provide and associate media elements.

Group II. Creating media clips or motion clips and media clips editing.

Group III. Creation of media programming, profiling a viewer and concatenating media clips.

See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Groups I and II are not required for Group III, the search required for Groups II and III are not required for Group I, and the search required for Groups I and

III are not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Gilbert G. Kovelman, Attorney for the Applicant, Reg. No. 19,552 on 13 September 2004, a provisional election was made without traverse to prosecute the invention of Group I, claims 104 – 110. Affirmation of this election must be made by applicant in replying to this Office action. Claims 111 – 130 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

EXAMINER'S AMENDMENT

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Gilbert G. Kovelman, Attorney for the Applicant, Reg. No. 19,552 on 13 September 2004.

The application has been amended as follows:

In the claim:

Please cancel claims 111 – 130.

Oath/Declaration

4. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The declaration is defective. It does not adequately identify at least one error as per CFR 1.175(a)(1).

Stating that one filed a broadening reissue because one "claimed too narrowly", without identifying the specific feature is not adequate. ("Rather, the oath/declaration must specifically identify an error").

The error is not claiming the material of Figure 3 which is not the "same invention" as the issued patent.

Furthermore, an exact copying of the new claim does not meet the requirement. ("it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error".) See MPEP 1414

There is no offer to surrender the patent. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

5. A new declaration is needed because original declaration is partially blocked out.

Specification

6. The disclosure is objected to because of the following informalities:

Examiner could not find the following:

The support for the claim is not found in the location provided by the applicant,

- stylistic approach of a user,
- the feature of the template "wherein" clause,
- automatically,
- used with said stylistic approach.

Appropriate correction is required.

7. Correction needed on pre-amendment filed on July 10, 2003.

Applicant needs to fill 10/xxx,xxx to 10/616,602.

Claim Rejections - 35 USC § 251

8. Claims 104 – 110 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.


The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shahid Al Alam
Primary Examiner
Art Unit 2162

7 October 2005